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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/349,737	07/08/1999	DEAN R. SHACKLETT	99-40132-US	7065

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EXAMINER

COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/28/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/349,737
Filing Date: July 8, 1999
Appellant(s): SHACKLETT

Edward F. Behm, Jr.
For Appellant

EXAMINER'S ANSWER

MAILED
MAR 28 2005
GROUP 1700

This is in response to the appeal brief filed December 21, 2004.

(1) Real Party in Interest

26

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

It is noted that related application 10/388,303 is also pending.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Art Unit: 1771

6,161,928	Morikawa et al	12-2000
5,776,854	Hayashi	7-1998
5,458,590	Schleinz et al	10-1995
6,096,412	McFarland et al	8-2000
5,984,443	Desie et al	11-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 2-9, 14-19, 63-75 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "extended time" is indefinite because it is not clear what length of time would constitute extended time.

Claims 2-9, 14-19, 63-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over either McFarland et al (6096412) or Schleinz et al *5458590) in view of Dainippon (JP 63091243A), Hayashi (5776854) or Morikawa et al (66928) and Desie et al (5894443). Both McFarland and Schleinz are concerned with the creation of printing ink on an absorbent nonwoven material. Neither reference specifically states the level of absorbency of said nonwovens, however, it is the examiner's position that both are capable of absorbing at least about 1.5 times the weight of the material. McFarland teaches the creation of a paper towel, (col. 22, lines 30-35) and Schleinz

Art Unit: 1771

teaches the creation of a backsheet for an absorbent diaper (col. 6, lines 60-65 and col. 8, lines 1-6). Both applications require a high rate of absorbency, therefore, it they do not inherently have applicant's claimed absorbency it would have been obvious to the skilled artisan to increase their absorbency in order to make them more efficient in their respective applications. Both references teach printing ink on at least one side of the web. With regard to the thickness set forth in claim 4, it would have been obvious to have varied the thickness of the material being printed, since a change in size is generally recognized as being within the level of ordinary skill in the art. With respect to claims 5, 8-9 and 19, Schleinz teaches that it is well known in the art to print on nonwovens formed from polyester and cellulose. Similarly, McFarland incorporates by reference about 17 patents, several of which teach nonwoven webs formed from a combination of polyester and cellulose. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use these materials in applicant's claimed amounts, since it has been held to be within the general skill of a worker in the art to select a known material based on its suitability for the intended use.

With respect to claims 6-7 and 18, it would have been well within the level of ordinary skill in the art to vary the density of said nonwoven webs in order to vary their absorbency characteristics, weight, and hand. It would also have been well within the level of ordinary skill in the art to form said webs so that they were circular.

McFarland and Schleinz differ from the claimed invention because they fail to teach using applicant's claimed vehicle for the ink.

Dainippon, Hayashi, and Morikawa are all concerned with printing inks on nonwoven substrates. All teach the use of applicant's claimed vehicles, (abstract; col. 1, lines 24-27 and col. 5, lines 21-23; col. 12, lines 1-15, respectively). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed the vehicles taught by Dainippon, Hayashi, and Morikawa in the ink of McFarland and Schleinz. Such a combination would have been motivated by the desire to provide the ink with a more uniform dispersion and improved mechanical strength.

The combination set forth above, does not seem to specifically teach printing both sides of a substrate in register. Desie teaches printing both sides of a web in register (col. 8, lines 50-65) It would have been obvious to one having ordinary skill in the art to have printed the on both sides of the material of McFarland or Schleinz., motivated the expectation of forming a product having uniform printing on both sides.

(10) Response to Argument

Appellant argues that the phrase "extended time" is definite because it would be apparent to one skilled in the art as it is a matter of degree and would be understood as being limited to non-fleeting periods of time, and would not include those fleeting periods of absorbcency and durability over which the materials in the cited art, such as the diapers and paper towels in McFarland and Schleinz, would degrade. However,

Art Unit: 1771

Appellant's argument raises more questions, in that it is not clear what is meant by non-fleeting. Would a day be non-fleeting, a week, a month? Neither the term employed in the claim, "extended time" nor the term set forth in the arguments, "non-fleeting" have a definite meaning. Further, both McFarland and Schleinz teach printing on substrates which comprise polyester. Polyester is generally not considered to be easily degradable or biodegradable. Also, it is noted that Appellants are employing the same materials to make up the substrate as are taught in McFarland and Schleinz.

Appellant argues that "over extended time" is "limited to non-fleeing periods of time, and thus does not include fleeting periods of time in which degradation may occur, such as those in McFarland and Schleinz", (brief at page 4, lines 11-13). However, there is no basis for this statement. McFarland and Schleinz both employ the same materials as the instant claims. There is no reason to suppose that the McFarland and Schleinz materials would degrade or not degrade differently than the claimed materials. There is nothing on the record to distinguish the claimed materials from the materials set forth in McFarland and Schleinz and nothing on which to base the assertion that somehow the phrase "over extended time" can be defined by comparing the instant claims to the material of McFarland and Schleinz and arbitrarily stating that the McFarland and Schleinz materials are examples of materials which degrade over "fleeting" periods of time and that therefore this somehow makes the phrase "extended time" definite.

Appellant asserts that “extended time” “is a term definite to those skilled in the art as meaning the length of time that a product might be exposed to a wet environment and necessitate non-degradation, such as in a medical container application”, (Brief at page 4). However, again there is nothing on the record to support this assertion, and there is nothing in the claims which has anything to do with medical container applications or with a particular shelf life of a particular product. The claims recite a printed non-woven wherein the non-woven is degradation resistant upon exposure to liquid “over extended time”. The claims do not recite a medical product, or recite combining the printed nonwoven with other products which have a definite known shelf life, or somehow relate the degradation resistance of the nonwoven to any particular liquid to which the nonwoven is exposed.

Appellant argues that if one skilled in the art can assess the meaning of “extended time” without undo experimentation, the phrase is not indefinite. However, since no guidance is provided for determining, it is not clear how the meaning of “extended time” could be determined with any amount of experimentation. Appellant argues that specific examples are provided within the specification. However, the specification merely sets forth that particular 100% polyester nonwovens and other materials can be used. It does not set forth any data regarding the degradation of the nonwovens or how long they would have to resist degradation in order to be degradation resistant for an extended time.

Appellant argues that the it has never been asserted that the claimed invention will never degrade but rather that the exemplary fabric pad Sontara ® is degradation resistant even when wet because it is durable and tear resistant and would be even when soaked in medicine for a non-fleeting period of time. However, the instant claims are not limited to a particular material. Additionally, as set forth above, the claims have nothing to do with soaking a pad in medicine. They simply recite that the nonwoven is degradation resistant upon exposure "over extended time". Finally, even if the claims were somehow limited to medical application, it still is not clear what is meant by extended time or fleeting time and what the dividing line is between the two.

Appellant argues that they do not have a duty to engage in experimentation in order to assess a specific endpoint or to perform extensive testing which would lead to a lengthy wait to obtain a patent. However, Appellant does have a duty to particularly point out and distinctly claim the invention. How Applicant does that is up to the Applicant, but the obligation to particularly point out the claimed invention must be met.

With regard to the art rejection, Appellant argues that there is no motivation to make the combination. However, Dainippon, Hayashi and Morikawa each teach that the claimed vehicles were well known in the art as vehicles for ink. Each teaches that employing these vehicles results in providing the ink with a more uniform dispersion and improved mechanical strength. Motivation to combine the references need not be expressly set forth in the references. In this case, the references show that these vehicles were well known materials which were known to be suitable for the purpose of forming a vehicle for inks. McFarland and Schleinz are not limited to particular ink

Art Unit: 1771

compositions. Therefore, since the particular inks set forth in Dainippon, Hayashi and Morikawa were well known at the time the invention was made, it would have been obvious to have selected these particular vehicles for the ink.

Appellant argues that the Declaration of Dean Shacklett sets forth there has been a long felt need for this combination. Appellant argues that if there were a motivation to combine the ink and pad, it would already have been done to meet the long felt need. However, while the Declaration states that the claimed subject matter solved a problem that was long standing in the art, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

Appellant argues the inks of the other cited art would not operable in the Desie process. However, Desie is relied on to show that it would have been obvious to have printed on both sides of the McFarland or Schleinz material.

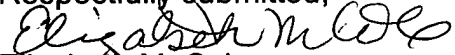
Appellant argues that the motivation to combine the references comes only from the instant claims and specification. However, as set forth above, Dainippon, Hayashi and Morikawa all teach that the particular inks and vehicles were well known in the art. McFarland and Schleinz both teach that a wide variety of inks and vehicles can be used. Therefore, the motivation to make the combination would have been found in the teachings of Dainippon, Hayashi and Morikawa that the claimed inks and vehicles were suitable for use for printing a variety of substrates. Therefore, the use of the particularly

Art Unit: 1771

claimed inks would have been a choice to select a material which was known to be suitable for the particular use.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Elizabeth M. Cole

Primary Examiner

Art Unit 1771

e.c.

March 15, 2005

Conferees

Terrel Morris

Rena Dye

